

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 50594
	:	
William PAGAN	:	Confirmation Number: 9436
	:	
Application No.: 10/092,840	:	Group Art Unit: 2173
	:	
Filed: March 7, 2002	:	Examiner: M. Roswell
	:	
For:		PULL-DOWN MENU MANIPULATION OF MULTIPLE OPEN DOCUMENT WINDOWS

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated March 8, 2007.

The Examiner's response to Appellant's arguments submitted in the Appeal Brief of November 6, 2006, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejections. In response, Appellant relies upon the arguments presented in the Appeal Brief of November 6, 2006, and the arguments set forth below.

THE REJECTION OF CLAIMS 1-14 UNDER THE FIRST PARAGRAPH OF 35 U.S.C. § 112

In the Amendment filed January 31, 2006, Appellant amended independent claims 1, 4, and 7 to clarify that the pre-defined window manipulation operation is separate from a focus change operation.¹ Appellant made this amendment in response to the Third Office Action dated November 1, 2005, because the Examiner continued to assert that a focus change operation is identically disclosed by Appellants' Admitted Prior Art (i.e., the disclosure in Appellant's Description of the Related Art), despite Appellant's prior arguments in two separate responses that a focus change operation was not a pre-defined window manipulation operation. On the basis of this interpretation by the Examiner, the Examiner continued to reject the claims under 35 U.S.C. § 102 for anticipation based upon the Admitted Prior Art. As a result of the Examiner's continued intransigence, Appellant was forced to amend the claims so as to more clearly distinguish the claimed invention over Appellant's own discussion of the Prior Art.

On page 4 of the Appeal Brief, to support the added limitation, Appellant made reference to page 7, lines 8-11 of Appellant's disclosure, which for ease of reference, is reproduced below:

In this way, a selected open document window in the pull-down menu list can be manipulated through another open document without requiring activation of the selected open document window. (emphasis added)

Appellant further argued that a focus change operation, as disclosed by the Admitted Prior Art, necessarily causes the activation of the selected open document. Thus, by disclosing that the manipulation occurs "without requiring activation of the selected open document window," this disclosure enables the recited feature of "performing a pre-defined window manipulation operation, separate from a focus change operation."

¹ In a typical windows-type operating system, only a single window at a time has the "focus." To change the focus of the window (i.e., a focus change operation), a user can, for example, click on a different open window or select a different window using alt-tab to activate the window. Upon so doing, a focus change operation has occurred and the focus of the operating system changes from one window to another window.

The Examiner's initial response to Appellant's arguments in the Appeal Brief is found in the second full paragraph on page 10 of the Examiner's Answer and reproduced below:

In response to Appellant's argument of pages 3 and 4 of the Brief, concerning the rejection of claims 1, 4 and 7 under 35 USC 112, 1~ paragraph, the examiner respectfully disagrees. Appellant has argued that page 7, lines 8-11 of Appellant's disclosure provides support for the negative limitation, "performing a pre-defined window manipulation operation, separate from a focus change operation, upon an inactive document window". The alleged support of the disclosure states, "a selected open document window in the pull-down menu list can be manipulated through another open document without requiring activation of the selected open document window". The examiner contends that this sentence merely discloses that a pull-down menu list in an active window may be used to manipulate an inactive window, and does not specifically exclude the cited window focus operation. No support in the specification exists excluding a focus change from the set of window manipulation operations, and the examiner contends that a focus change is indeed a window manipulation operation. (emphasis added)

Appellant is astounded by the above-underlined assertion from the Examiner. A focus change operation and the activation of an open document window are one and the same. A review of the art reveals that the terms "focus" and "activation" are used synonymously. For example, Java™ 2 Platform Std. Ed. v1.4.2² describes the "WINDOW_ACTIVATED" event as follows:

The window-activated event type. This event is delivered when the Window becomes the active Window. Only a Frame or a Dialog can be the active Window. The native windowing system may denote the active Window or its children with special decorations, such as a highlighted title bar. The active Window is always either the focused Window, or the first Frame or Dialog that is an owner of the focused Window.

Therefore, since a focus change operation of a window and the activation of a window are synonymous, page 7, lines 8-11 of Appellant's disclosure can be read as disclosing that a selected open document window in the pull-down menu list can be manipulated through another open document without requiring a focus change operation. Such a disclosure supports Appellant's amendment to the claims to clarify that the pre-defined window manipulation operation is separate from a focus change operation since the pre-defined window manipulation is also claimed as being performed "upon an inactive open document."

² http://java.sun.com/j2se/1.4.2/docs/api/java/awt/event/WindowEvent.html#WINDOW_ACTIVATED.

If Appellant's disclosure were read to not specifically exclude a focus change operation, which is the position asserted by the Examiner, then page 7, lines 8-11 of Appellant's disclosure could be read as disclosing that a selected open document can be activated (i.e., the Examiner alleges that a focus change operation is a window manipulation operation) without requiring activation of the selected open document window. In short, the Examiner is alleging this passage could teach that "a document can be activated without requiring activation of the document." Thus, as readily apparent from such a logically inconsistent teaching, the Examiner's assertion leads to a nonsensical interpretation of page 7, lines 8-11 of Appellant's disclosure..

The Examiner's further asserted the following in the paragraph spanning pages 10 and 11 of the Examiner's Answer:

Generally, the above-cited portion discloses that a pull-down menu in an active window may be used to manipulate an inactive window. Many window manipulation operations exist, including but not limited to saving, closing and printing a window, as claimed. The examiner contends that a focus change is indeed a window manipulation operation. Therefore, as the pull-down menu cited in Appellant's disclosure may be used to change the focus, instead of some other well-known means of focus change (for example, the alt-tab function or selection of a window tab in the taskbar as is found in Microsoft Windows operating systems), the pull-down menu as cited allows the manipulation of inactive windows.

This passages merely repeats the Examiner's assertion that "a focus change is indeed a window manipulation operation." The Examiner's analysis, however, neglects to reconcile why Appellant allegedly disclosed in the Admitted Prior Art that a focus change is a window manipulation operation yet in the first full paragraph on page 8 of Appellant's disclosure, while describing different types of window manipulation operations, a discussion of a focus change operation is conspicuously absent. If, as alleged by the Examiner, Appellant taught a focus change operation as a window manipulation operation, then it would be natural for Appellant to

include a focus change operation as another example of a window manipulation operation in the discussion in the first full paragraph on pages 8 of Appellant's disclosure.

The reason why a focus change operation was not included in the discussion of different types of window manipulation operations in the discussion in the first full paragraph on pages 8 of Appellant's disclosure is because Appellants did not at the time the application was drafted and still do not consider a focus change operation as being a type of windows manipulation operation. For the Examiner to allege otherwise is comparable to the Examiner alleging that Appellant knowingly presented claims that read on the art described in Appellant's own disclosure. Appellant's position is that one having ordinary skill in the art, upon reading Appellant's disclosure, would have recognized that Appellant specifically excluded focus change operations from the claimed window manipulation operations.

THE REJECTION OF CLAIMS 1-14 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON THE ADMITTED PRIOR ART IN VIEW OF BEAUDET

On pages 5-7 of the Appeal Brief, Appellant argued that the Examiner failed to establish a realistic motivation to modify the Admitted Prior Art in view of Beaudet. In response, the Examiner asserted the following in the first full paragraph on page 11 of the Examiner's Answer.

In this case, a functionality similarity exists between the admitted prior art and the window control management system of Beaudet, in that both are capable of carrying out window manipulation operations on inactive windows. Furthermore, although the manipulation system of the admitted prior art is in a pull-down menu, and the manipulation system of Beaudet is found in a separate window, it can be seen that both are a similar list of windows. Beaudet at col. 2, lines 1-9 states the importance of providing a convenient means for performing operations on a window. Therefore, one would have been motivated to include the window manipulation operations of Beaudet into the pull-down window manipulation menu of the admitted prior art, as the aforementioned pull-down menu is located neatly within the active window and is thus readily available to the user through simple interface manipulation.

As evident from the first sentence of the above-reproduced passage, the Examiner is employing an impermissible "obvious to try" argument by asserting that since these references are allegedly similar, it would have been obvious to modify one in view of the other.

Moreover, the Examiner has failed to factually establish that one having ordinary skill in the art would have recognized that both the "focus change operation" of the Admitted Prior Art and the operations³ described in column 7, lines 17-49 of Beaudet correspond to the claimed window manipulation operation. The Examiner's analysis improperly concludes that the operations respectively disclosed by the Admitted Prior Art and Beaudet are species of the genus window manipulation operation without any factual support. The Examiner has not pointed to any teaching within the applied prior art or any other reference that supports this conclusion. Instead, the Examiner's conclusion is based solely upon the Examiner's "say so."

Appellant also notes that the Examiner did not address Appellant's arguments on page 6 of the Appeal Brief that the Examiner's asserted benefit from modifying the applied prior art is based upon a generalization without clear and particular factual findings as to a specific understanding or specific technological principle which would have realistically impelled one having ordinary skill in the art to modify the applied prior art to arrive at the claimed invention. Instead, the Examiner's analysis appears to be based upon impermissible hindsight reconstruction of the claimed invention.

³ Beaudet describes a "response" operation; a "maximize" operation; a "minimize" operation, and a "close" operation.

Neither the Admitted Prior Art nor Beaudet specifically teach the broad concept of a window manipulation operation, yet the Examiner has come to the conclusion, without any factual support, that both of these references teach a window manipulation operation. Moreover, the claimed invention recites that activation of the window manipulation operation occurs in a pull-down menu, whereas Beaudet discloses the use of a separate control window, yet the Examiner dismisses this difference since "both are a similar list of windows," again without factual support. On the contrary, a comparison of feature 10c (i.e., control window) of Fig. 4 within Beaudet to feature 140 (i.e., window list) of Fig. 1 within the Admitted Prior Art yields two very different features. Furthermore, the Examiner has not explained how one having ordinary skill in the art would have incorporated the feature-intensive control 10c of Beaudet within the window list 140 of the Admitted Prior Art.

On pages 7-11 of the Appeal Brief, Appellant argued that the Examiner failed to properly determine the differences between the scope and content of what is claimed and the scope and content of what is actually taught by the applied prior art. The Examiner's response to these arguments is found in the paragraph spanning pages 11 and 12 of the Examiner's Answer and reproduced below:

Appellant's arguments of pages 7-11 are similar to arguments stated above (the relevant teachings of the admitted prior art, the obviousness and subsequent result of a combination between the admitted prior art and the Beaudet reference), and those deemed redundant will not be repeated for the sake of brevity. The examiner maintains that the motivation provided in the rejection of the claims, the response to arguments above, and the resulting combination of the admitted prior art and Beaudet would be sufficient to produce the invention as claimed.

Appellant notes that the Examiner's prior arguments in the Appeal Brief were directed to the Examiner's failure to establish a proper motivation to modify the Admitted Prior Art in view of Beaudet. On the contrary, the arguments found on pages 7-11 of the Appeal Brief are directed to how the Examiner has characterized the differences between the claimed invention and what is

taught by the applied prior art. Specifically, Appellant has argued that the Examiner has mischaracterized both the differences between the claimed invention and the applied prior art and what the applied prior art actual teaches. Thus, the Examiner has failed to address the arguments made by Appellant on pages 7-11 of the Appeal Brief.

On pages 11-13 of the Appeal Brief, Appellant argued that the applied prior art, even if combined, would not result in the claimed invention. The Examiner's response to these arguments is found in the first full paragraph on page 12 of the Examiner's Answer and reproduced below:

In response to Appellant's arguments of pages 11-13, the examiner respectfully disagrees. Appellant has argued on page 12 that "the fact that Beaudet did not recognize this so-called 'obviousness modification' is evidence that the claimed invention was not obvious to one having ordinary skill in the art", and on page 13 that, 'if as asserted by Appellant, that Beaudet was aware of the teachings of the Admitted Prior Art, then the fact that Beaudet did not arrive at the claimed invention is also indicia of nonobviousness'. The examiner contends that Appellant's logic in this assertion is flawed. The examiner reiterates the prior statement that "because a modification is obvious does not necessitate that it must be done". For example, a car may come in various colors, with various interiors and amenities. This does not mean that a buyer must purchase a single car that has every color, with every interior and every amenity because he can. Similarly, there are a plurality of menu types to be found in state-of-the-art graphical user interfaces, such as the pull-down menu of the admitted prior art, the iconic array of Beaudet, graphical toolbars, three-dimensional displays, pop-up menus, etc. Therefore, the examiner contends that because Beaudet does not teach his menu interface as a pull-down menu, graphical toolbar, three-dimensional display, pop-up menu, or any other type of menu system available to one of ordinary skill in the art, does not mean that it cannot be [sic] done. Subsequently, as shown above, the examiner believes that ample motivation exists to include the functionality of the menu system of Beaudet into the pull-down menu system of the admitted prior art.

Unlike many obviousness analysis, in which the "one having ordinary skill in the art at the time of the invention" is deemed to have knowledge of all the relevant art despite this being a legal fiction, one having ordinary skill in the art (i.e., Beaudet et al.) at the time of the invention must have had knowledge of both Beaudet and the Admitted Prior Art. The Admitted Prior Art is being relied upon only to disclose the use of pull-down menus, yet the product windows 31, 35 of Beaudet already include pull-down menus (i.e., Database, View, and Help) and presumably the

"View" pull-down menu would include the ability to perform a focus change operation since this type of pull-down window has long been found in windows-type operating systems. Thus, Beaudet would have necessarily had knowledge of all the elements used in the Examiner's obviousness rejection. However, despite this knowledge, Beaudet did not recognize this so-called "obvious modification."

The example provided by the Examiner in the above-cited passage is not germane. A buyer cannot purchase "a single car that has every color, with every interior and every amenity" because the selection of certain options preclude other options from being selected. In contrast, nothing prevents Beaudet from modifying the teachings of the Admitted Prior Art (which are also found in Beaudet).

Appellant's position is that the Examiner has not taken into consideration the fact that Beaudet did not recognize this alleged obvious modification. In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to establish that the claimed invention would have been obvious over the applied prior art. The difference between "could have been obvious" and "would have been obvious" is manifested in the Examiner's burden of proof in determining patentability. The ultimate determination of patentability is based on the entire record, by a preponderance of the evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence.⁴ The legal standard of "a preponderance of the evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it.⁵ Thus, given due consideration to the arguments presented above and the fact that Beaudet did not arrive at the claimed invention, despite

⁴ In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

⁵ M.P.E.P. § 2142.

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having all the teachings allegedly necessary to arrive at the claimed invention, Appellant respectfully submits that one having ordinary skill in the art at the time of the invention would not have found the claimed invention obvious over the applied prior art.

For the reasons set forth in the Appeal Brief of November 6, 2006, and for those set forth herein, Appellant respectfully solicits the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 103, 112.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: May 8, 2007

Respectfully submitted,

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